

DOCKET NO: 2543-0015-2



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

BRUCE CLEVELAND, ET AL. : EXAMINER: GRAHAM, C. B.

SERIAL NO: 09/510,984 :

FILED: FEBRUARY 22, 2000 : GROUP ART UNIT: 3628

FOR: METHOD, SYSTEM AND
COMPUTER PROGRAM PRODUCT FOR
HISTORICAL ACCOUNT STATEMENTS

APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants appeal the outstanding Final Rejection of July 17, 2006, finally rejecting each of pending claims 1-4, 6-12, 14-18, and 20-23.

I. REAL PARTY IN INTEREST

The above-noted application is assigned to Presidential Bank, FSB, which is the real party in interest, having a place of business at Bethesda, MD.

II. RELATED APPEALS AND INTERFERENCES

Applicant and Applicant's representative are not aware of any related appeals or interferences that will directly effect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-4, 6-12, 14-18, and 20-23 are pending in this application and the rejection of each of claims 1-4, 6-12, 14-18, and 20-23 is being appealed.

Claims 5, 13, and 19 were cancelled, and Claims 21-23 were added during prosecution of this application.

IV. STATUS OF AMENDMENTS

An Amendment was filed on April 14, 2006, subsequent to the Office Action dated December 19, 2005. In response to the Amendment, the outstanding non-final Office Action dated July 17, 2006, was mailed. Accordingly, all previously filed Amendments have been considered by the Examiner and are reflected in the attached claims.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The applicants of the present invention recognized that a problem exists in the current art in that until the present invention there was not a method and system for storing, retrieving, and displaying an historical account statement online by using a non-graphical version of the account statement used for printing the account statement, such that the displayed account statement is identical to an original printed account statement.

Accordingly, Claim 1 sets forth a method reciting the step of formatting first formatted account information into second formatted account information, which finds support, e.g., in the flowcharts of Figures 2A-2C; and page 8, line 5 to page 11, line 10 of the specification.

Further, Claim 1 recites storing said second formatted account information in a storage area, without storing graphical images of an original printed account statement,

which finds support, e.g., in step 252 of Figure 2B; and page 6, line 22 to page 7, line 3 of the specification.

Further, Claim 1 recites interactively inputting a request for said second formatted account information, which finds support, e.g., in the flowcharts of Figure 3A and 3B; Figure 5A; and page 11, lines 11-16 of the specification.

In addition, Claim 1 recites transferring said second formatted account information from said storage area to a display device for displaying said second formatted account information in a format that is identical to the original printed account statement, which finds support, e.g., in step 348 of Figure 3B; Figures 5B-5D; and page 11, line 13 to page 12, line 7 of the specification.

Further, Claim 1 clarifies that the first formatted account information comprises formatted information for said original printed account statement, which finds support, e.g., in Figures 5B-5D; and page 11, line 23 to page 12, line 7 of the specification.

In addition, Claim 1 clarifies that the second formatted account information is formatted in HTML, which finds support, e.g., in step 274 of Figure 2C; Figures 6A-6H; and page 16, line 23 to page 17, line 17 of the specification.

Finally, Claim 1 clarifies that the transferring step includes superimposing said second formatted account information on a background image corresponding to a background of the original printed account statement, which finds support, e.g., in page 11, line 23 to page 12, line 7; and page 17, lines 1-13 of the specification.

Independent Claim 9 (directed to a system) and Claim 15 (directed to a computer program product) recite limitations analogous to the limitations recited in Claim 1 and are supported by the originally filed specification and drawings in a manner analogous to the support for Claim 1 described above. The system of Claim 9 and the computer program product of Claim 15 are generally supported by the system and computer hardware shown in

Figures 1, 7A, and 7B. In particular, Claim 9 is directed to a system, comprising: (1) a formatting device (see Figure 7A, element 708) configured to format first formatted account information into second formatted account information; (2) a storing device (see Figure 7B, element 730) configured to store said second formatted account information in a storage area, without storing graphical images of an original printed account statement; (3) an input device (see Figure 7A, element 702) configured to interactively input a request for said second formatted account information; and (4) a transferring device (see Figure 7A, elements 706 and 708) configured to transfer said second formatted account information from said storage area to a display device for displaying said second formatted account information in a format that is identical to the original printed account statement. Further, Claim 9 clarifies that (1) said first formatted account information comprises formatted information for said original printed account statement; (2) said second formatted account information is formatted in HTML; and (3) said transferring device is configured to superimpose said second formatted account information on a background image corresponding to a background of the original printed account statement.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The sole ground of rejection being appealed is whether the teachings of U.S. Patent No. 6,249,770 to Erwin et al. (hereinafter “the ‘770 patent”) in view of U.S. Patent No. 5,608,874 to Ogawa et al. (hereinafter “the ‘874 patent”) and U.S. Patent No. 5,848,413 to Wolff (hereinafter “the ‘413 patent”) render obvious the subject matter of Claims 1-4, 6-12, 14-18, and 20-23 under 35 U.S.C. § 103(a).

In addition, Applicants respectfully submit that the outstanding rejections of Claims 1, 9, and 15 under 35 U.S.C. § 112, second paragraph, were withdrawn by the Examiner, as evidenced by the Interview Summary of record dated August 2, 2006. Applicants note that

the outstanding Office Action includes a rejection of Claims 1, 9, and 15 under 35 U.S.C. § 112, second paragraph, regarding the limitation "second formatted account information" and "appears identical." However, in an interview on August 2, 2006, Applicants' representative discussed this rejection with the Examiner. In particular, it was pointed out that the term "appears identical" was deleted from the claims in the Amendment filed April 14, 2006. Moreover, Applicants' representative also pointed out that the Amendment filed April 14, 2006, provided a discussion of support in the specification for the claimed "second account information" and how graphical images of the original printed account statement are not stored. At the conclusion of the interview, the Examiner agreed to withdraw the rejections of the claims under 35 U.S.C. § 112, second paragraph. Applicants proceeded to file a Notice of Appeal to appeal the rejections under 35 U.S.C. § 103(a).

VII. ARGUMENT

Claim 1 is directed to method, comprising: (1) formatting first formatted account information into second formatted account information; (2) storing said second formatted account information in a storage area, without storing graphical images of an original printed account statement; (3) interactively inputting a request for said second formatted account information; and (4) transferring said second formatted account information from said storage area to a display device for displaying said second formatted account information in a format that is identical to the original printed account statement. Further Claim 1 clarifies that said first formatted account information comprises formatted information for said original printed account statement; said second formatted account information is formatted in HTML; and said transferring step includes superimposing said second formatted account information on a background image corresponding to a background of the original printed account statement.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a), the Office Action asserts that the '770 patent discloses everything in the claims with the exception of (1) formatting first formatted account information into second formatted account information, and (2) transferring a second formatted account information from a storage area to a display device, wherein the transferring step includes superimposing the second formatted account information on a background image corresponding to a background of the original printed account statement, and relies on the '874 and '413 patents to remedy those deficiencies.

The '770 patent is directed to a method and system for automatically analyzing historical financial statements and generating financial forecasts. As shown in Figure 4, the '770 patent discloses a system that receives and stores accounting information about a company and, based on financial models, automatically generates and displays financial forecasts for the company including operating profitability and cash flow estimates. However, as admitted in the Office Action, the '770 patent fails to disclose transferring second formatted account information from a storage area to a display device for displaying the second formatted account information in a format that is identical to the original printed account statement. Moreover, as admitted in the Office Action, the '770 patent fails to disclose that the second formatted account information is formatted in HTML, and that the transferring step includes superimposing the second formatted account information on a background image corresponding to a background of the original printed account statement, as recited in Claim 1.

The '874 patent is directed to a system and method for automatic data file format translation. The '874 patent discloses receiving data from a wide variety of remote sources, identifying the format of the data, translating the data into a common file format, and then converting the data to a specific format needed for a particular recipient. However, as admitted in the Office Action, the '874 patent fails to disclose that the second formatted

account information is formatted in HTML, and that the transferring step includes superimposing the second formatted account information on a background image corresponding to a background of the original printed account statement, as recited in Claim 1. Further, Applicants respectfully submit that the '874 patent fails to disclose displaying the second formatted account information in a format that is identical to the original printed account statement, as recited in Claim 1. The '874 patent is directed to methods of data format translation, not to the displayed appearance of formatted account information.

The '413 patent is directed to a document retrieval and accessing system in which documents are provided with links to other documents and selection of one or more of the links causes the corresponding documents to be retrieved and sent to the requesting party. As shown in Figure 4, the '413 patent discloses that a gateway machine 102 receives a fax from a user, such as the fax shown in Figure 3, wherein a link has been circled by the user. As shown in Figure 5, the gateway machine first extracts the circled regions from the received fax image to obtain machine readable information, decodes the information obtained, and determines the identifier/locator based on the decoded information. As shown in Figure 4, the '413 patent discloses that the desired documents are retrieved and an image is created of each of the retrieved documents, which are then sent by facsimile transmission to the user.

Regarding step 404 in Figure 4, the '413 patent discloses that

...gateway 102 creates images by parsing, formatting and rendering the documents. The parsing of the documents, as well as formatting and rendering of the parsed documents, includes the conversion of document identifiers/locators associated with the retrieved documents to a machine readable code (e.g., barcode, digital paper, etc.) to be included in the images faxed to the user (to enable user selection of additional documents). Rendering is necessary for most documents to convert the data from ASCII to a raster bit map, the protocol used by fax machines (and other marking engines).¹

¹ '413 patent, column 6, lines 40-50.

However, Applicants respectfully submit that the '413 patent fails to disclose a step of transferring second formatted account information from a storage area to a display device for displaying the second formatted account information including superimposing the second formatted account information on a background image corresponding to a background of the original printed account statement, as recited in Claim 1. Rather, the '413 patent merely discloses that a user faxes a document in which hyperlinks have been circled to a gateway machine which then retrieves the circled documents and creates an image to be faxed back to the user. The '413 patent is silent regarding a background image corresponding to a background of an original printed account statement, as recited in Claim 1. In this regard, Applicants note that a word search of the '413 patent indicates that the '413 patent fails to contain the word "superimposing" or the word "background". Moreover, Applicants note that the outstanding Office Action fails to specifically identify how the '413 patent discloses this limitation. Rather, the outstanding Office Action merely discusses the '413 patent in general terms and refers Applicant to columns 2-5 of the '413 patent.²

Thus, no matter how the teachings of the '770, '874, and '413 patents are combined, the combination does not teach or suggest a transferring step that includes superimposing a second formatted account information on a background image corresponding to a background of the original printed account statement, as recited in Claim 1. In particular, Applicants respectfully submit that ***none of the cited references discloses any relationship between a printed account statement and the displaying of an image that corresponds to a printed account statement***, as required by Claim 1. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claim 1 (and dependent Claims 2-4, 6-8, and 21) should be withdrawn.

² See pages 4 and 5 of the outstanding Office Action.

Further, no matter how the teachings of the '770, '874, and '413 patents are combined, the combination does not teach or suggest displaying the second formatted account information in a format that is identical to the original printed account statement. In this regard, Applicants note that the Examiner has failed to specifically address this and similar limitations in any Office Action, despite repeated discussions of this limitation in personal interviews and in responses to Office Actions.³

Moreover, even assuming for the sake of argument that the cited references disclose all of the limitations recited in Claim 1, the Office Action has failed to provide the requisite motivation to combine the teachings of the references. Regarding the motivation to combine, the Federal Circuit has held that

[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with....The factual question of motivation is material to patentability, and can not be resolved on subjective belief and unknown authority.⁴

Regarding the motivation to combine the teachings of the '770, '874, and '413 patents, the Office Action states that "[t]he benefit would have been to store account information that can be made available for retrieval online by display and periodic, printing or mailing of statements"⁵ and that it would have been obvious to make the suggested combination "in order to transfer an HTML document information, on a background image."⁶ Thus no facts, only unsupported conclusions, have been cited in the record regarding the motivation to combine the teachings of the cited references. In particular, Applicants submit that the Office Action is simply stating perceived advantages of Applicant's invention as motivation to combine the teachings of the '770, '874, and '413 patents without identifying that, absent

³ See, e.g., the Amendment filed December 5, 2002; the Request for Reconsideration filed June 3, 2003; and the Interview Summary dated October 5, 2004.

⁴ In Re Sang-Su Lee, 277 F.3d 1338 (Fed. Cir. 2002). Emphasis added.

⁵ Office Action dated July 17, 2006, page 4, lines 1-2.

⁶ *Id.* at page 4.

Applicants' specification, one of ordinary skill in the art would have even thought to address the problem. Such hindsight reconstruction of Applicants' invention cannot be used to establish a *prima facie* case of obviousness.

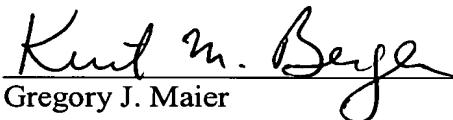
Independent Claims 9 and 15 recite limitations analogous to the limitations recited in Claim 1. Accordingly, for at least the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejections of Claim 9 (and dependent Claims 10-12, 14, and 22) and Claim 15 (and dependent Claims 16-18, 20, and 23) should be withdrawn.

VIII. CONCLUSION

For the foregoing reasons, Applicant respectfully submits that each of Claims 1-4, 6-12, 14-18, and 20-23 patentably distinguishes over the combination of teachings of the '770, '874, and '413 patents. Therefore, the outstanding rejections must be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599
Kurt M. Berger, Ph.D.
Registration No. 51,461

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)
GJM/KMB:smi

I:\ATTY\KMB\2543-0015\25430015.APPEAL.BRIEF2.DOC

CLAIMS APPENDIX

1. (Rejected) A method, comprising:

formatting first formatted account information into second formatted account information;

storing said second formatted account information in a storage area, without storing graphical images of an original printed account statement;

interactively inputting a request for said second formatted account information; and transferring said second formatted account information from said storage area to a display device for displaying said second formatted account information in a format that is identical to the original printed account statement,

wherein said first formatted account information comprises formatted information for said original printed account statement;

said second formatted account information is formatted in HTML; and

said transferring step includes superimposing said second formatted account information on a background image corresponding to a background of the original printed account statement.

2. (Rejected) The method according to Claim 1, wherein said first formatted account information comprises an American Standard Code for Information Interchange (ASCII) print image file.

3. (Rejected) The method according to Claim 1, wherein said storage area is included in a Standard Query Language (SQL) database server.

4. (Rejected) The method according to claim 1, wherein said step of interactively inputting comprises one of:

interactively inputting, by a first customer of a first business, a request for said second formatted account information by using a graphical user interface,

interactively inputting, by a software agent of a second customer of a second business, a request for said second formatted account information by using a graphical user interface,

interactively inputting, by a first member of a first organization, a request for said second formatted account information by using a graphical user interface, and

interactively inputting, by a software agent of a second member of a second organization, a request for said second formatted account information by using a graphical user interface.

5. (Canceled)

6. (Rejected) The method according to Claim 1, wherein said step of formatting comprises formatting said first formatted account information into said second formatted account information using a compression algorithm for compressing said first account information and for indicating formatting information of said printed account statement in said second formatted account information.

7. (Rejected) The method according to Claim 1, wherein said account information comprises account information for at least one of a customer of a first organization and a member of a second organization.

8. (Rejected) The method according to Claim 7, wherein said first organization comprises at least one of

- a bank,
- a credit union,
- a utility,
- a gasoline company,
- an airline,
- a distributor,
- a supplier to businesses,
- a retail merchant, and
- a credit card company.

9. (Rejected) A system, comprising:

- a formatting device configured to format first formatted account information into second formatted account information;
- a storing device configured to store said second formatted account information in a storage area, without storing graphical images of an original printed account statement;
- an input device configured to interactively input a request for said second formatted account information; and
- a transferring device configured to transfer said second formatted account information from said storage area to a display device for displaying said second formatted account information in a format that is identical to the original printed account statement,

wherein said first formatted account information comprises formatted information for said original printed account statement;

said second formatted account information is formatted in HTML; and

said transferring device is configured to superimpose said second formatted account information on a background image corresponding to a background of the original printed account statement.

10. (Rejected) The system according to Claim 9, wherein said first formatted account information comprises an ASCII print image file.

11. (Rejected) The system according to Claim 9, wherein said storage area is included in a SQL database server.

12. (Rejected) The system according to Claim 9, wherein said input device is further configured to perform one of:

 interactively inputting, by a first customer of a first business, a request for said second formatted account information by using a graphical user interface,

 interactively inputting, by a software agent of a second customer of a second business, a request for said second formatted account information by using a graphical user interface,

 interactively inputting, by a first member of a first organization, a request for said second formatted account information by using a graphical user interface, and

 interactively inputting, by a software agent of a second member of a second organization, a request for said second formatted account information by using a graphical user interface.

13. (Canceled)

14. (Rejected) The system according to Claim 9, wherein said formatting device comprises a compression device configured to compress said first account information and to indicate formatting information of said printed account statement in said second formatted account information by using a compression algorithm.

15. (Rejected) A computer program product including a computer readable medium embodying program instructions for causing a system to perform the steps of:

formatting first formatted account information into second formatted account information;

storing said second formatted account information in a storage area, without storing graphical images of an original printed account statement;

interactively inputting a request for said second formatted account information; and transferring said second formatted account information from said storage area to a display device for displaying said second formatted account information in a format that is identical to the original printed account statement,

wherein said first formatted account information comprises formatted information for said original printed account statement;

said second formatted account information is formatted in HTML; and

said transferring step includes superimposing said second formatted account information on a background image corresponding to a background of the original printed account statement.

16. (Rejected) The computer program product according to Claim 15, wherein said first formatted account information comprises an ASCII print image file.

17. (Rejected) The computer program product according to Claim 15, wherein said storage area is included in a SQL database server.

18. (Rejected) The computer program product according to Claim 15, wherein said step of interactively inputting comprises one of:

interactively inputting, by a first customer of a first business, a request for said second formatted account information by using a graphical user interface,

interactively inputting, by a software agent of a second customer of a second business, a request for said second formatted account information by using a graphical user interface,

interactively inputting, by a first member of a first organization, a request for said second formatted account information by using a graphical user interface, and

interactively inputting, by a software agent of a second member of a second organization, a request for said second formatted account information by using a graphical user interface.

19. (Canceled)

20. (Rejected) The computer program product according to Claim 15, wherein said step of formatting comprises formatting said first formatted account information into said second formatted account information using a compression algorithm for compressing said first account information and for indicating formatting information of said printed account statement in said second formatted account information.

21. (Rejected) The method of claim 1, wherein said background image includes at least one of a watermark image, a letterhead image, and a screened image.

22. (Rejected) The system of claim 9, wherein said background image includes at least one of a watermark image, a letterhead image, and a screened image.

23. (Rejected) The computer program product of claim 15, wherein said background image includes at least one of a watermark image, a letterhead image, and a screened image.

EVIDENCE APPENDIX

None

RELATED PROCEEDING APPENDIX

None